

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 10/607,208

REMARKS

Claims 12-22 are all the claims pending in the application. Claims 13, 16-18 and 20-22 are withdrawn from consideration as being drawn to a non-elected invention. Claims 12, 14, 15 and 19 presently stand rejected.

Applicants elected Species II, Fig. 4 for examination on which claims 12, 14, 15 and 19-21 are readable. The Examiner has indicated in the Office Action that claims 20 and 21 do not read on Species II, and has withdrawn claims 20 and 21.

Claims 12, 14, 15 and 19 are rejected under 35 U.S.C. § 112, second paragraph, for being indefinite. Applicants amend the claims to remove any ambiguities.

Claims 12, 14, 15 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art in view of Seelinger (4,438,888).

Analysis

The present invention is distinguishable from the admitted prior art because the guide mechanism has a coefficient of dynamic friction of less than 3. The admitted prior art uses a hard chrome plating surface which has a coefficient of dynamic friction of 3-5 (see page 6 of specification).

With this feature, the present invention is able to control the tensile strength of the material, so that there is no difference in tensile strength between the upstream and downstream sides of the guide mechanism.

Seelinger is also directed to a web reel. This reference briefly mentions the use of idler rollers 18 (col. 4, lines 39-41). According to the figures, there are a plurality of rollers. There is

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no teaching or suggestion of the coefficient of dynamic friction. Moreover, this reference specifically teaches that the “layers of tape 12 are wound onto the outer hub 46 under a relatively high tension” (col. 6, lines 3-4) and that the “ends of the tape 12 are then fastened to the outer hubs 46 of the supply reels 20” (col. 6, lines 49-50) as they are reeled from the idler rollers 18 onto the supply reel 20. Thus, the tape 12 is held with a high tension and there is no teaching or suggestion that the tensile strength at the idler rollers should have no difference between the upstream and downstream sides. In fact, since a high tension is desired, the Examiner motivation for modifying the admitted prior art that it would have been obvious to eliminate the tensile strength differences is unsupported. There is simply no teaching or suggestion in Seelinger to modify the admitted prior art to have a particular coefficient of friction which would eliminate the tension differences.

Still further, there is no teaching or suggestion in either reference that the coefficient of friction on the guide mechanism could be manipulated to eliminate the difference in tension in the first place. According to MPEP § 2144.05, a particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. See also, *In re Antonie*.¹

Since there is no teaching or suggestion in the cited references that the coefficient of friction achieves the elimination of the tension difference, one would not have thought to have arrived at the claimed coefficient of dynamic friction of less than 3.

¹ 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

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In view of the foregoing, each of claims 12, 14 and 15 is patentable. Moreover, claim 19 is patentable for at least the same reasons noted above, by virtue of its dependency from claim 15.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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